

Application No. 10/065,217
Docket No. 17MY-7239
Amendment dated June 7, 2006
Submission Accompanying RCE under 37 CFR §1.114

REMARKS

In the Office Action filed February 7, 2006, claims 1-10 were rejected under 35 USC §112, first paragraph, claims 1-10 were rejected under 35 USC §103 in view of U.S. Patent No. 4,810,467 to Wood et al. (Wood), claims 1-20 were rejected under 35 USC §103 in view of U.S. Patent No. 4,039,330 to Shaw, and claims 1-10 were provisionally rejected under the judicially-created doctrine of obviousness-type double patenting in view of claims 1-10 of co-pending U.S. Patent Application Serial No. 10/065,225 (now U.S. Patent No. 7,014,723) to Beck et al. (Beck). In response, Applicants have amended the claims as set forth above. More particularly:

Independent claim 1 has been amended to recite the Ta contents and the upper limit of the Al+Ti contents corresponding to Alloys 5, 6, and 7 of Table I of Applicants' specification.

Dependent claim 2, which depends from claim 1, has been amended to recite the Al+Ti content corresponding to Alloy 5 of Table I.

Dependent claim 3, which depends from claim 1, has been amended to recite the aluminum content corresponding to Alloy 6 of Table I.

Dependent claim 7, which depends from claim 1, has been amended to recite the Al+Ti content corresponding to Alloy 7 of Table I.

Independent claim 10 has been amended to recite the primary

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compositional ranges corresponding to Alloys 5, 6, 7, and 8 of Table I, and to use the term "approximately" consistent with paragraph [0014] of the specification.

Independent claim 11 has been amended to recite the Al and Al+Ti contents corresponding to Alloys 1, 2, and 3 of Table I.

Dependent claim 12, which depends from claim 11, has been amended to recite the Al+Ti content corresponding to Alloy 1 of Table I.

Dependent claim 13, which depends from claim 11, has been amended to recite the aluminum content corresponding to Alloy 2 of Table I.

Dependent claim 17, which depends from claim 11, has been amended to recite the Al+Ti content corresponding to Alloy 3 of Table I.

Dependent claims 18 and 19 have been amended to depend from claim 13.

Independent claim 20 has been amended to recite the primary compositional ranges corresponding to Alloys 1, 2, and 3 of Table I, and to use the term "approximately" consistent with paragraph [0014] of the specification.

New dependent claim 21 recites the aluminum content of Alloy A in Table VI.

New dependent claim 22, which depends from claim 10, recites the Al+Ti range for Alloys 5 and 7 of Table I.

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New dependent claims 23, 24, and 26, which depend from claim 10, recite the same limitations as amended claims 2, 3, and 7, respectively.

New dependent claim 25 recites the aluminum content of Alloy 8 of Table I.

New dependent claim 27 recites the same limitation as claim 4.

New dependent claim 28, which depends from claim 20, recites the Al+Ti range for Alloys 1 and 3 of Table I.

New dependent claims 29-31, which depend from claim 20, recite the same limitations as amended claims 12, 13, and 17, respectively.

New dependent claim 32 recites the same limitation as claim 14.

Applicants believe that the above amendments do not present new matter. Favorable reconsideration and allowance of claims 1-30 are respectfully requested in view of the above amendments and the following remarks.

Rejection under 35 USC §112, first paragraph

Claims 1-10 were rejected under 35 USC §112, first paragraph, on the basis that the end points of ranges for aluminum and Al+Ti in claims 1, 7, 10, and 17, and the range for aluminum in claim 7 did not find express support in the specification. Specifically, the Examiner explained

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the applicants have not cited specific support for the specific end point chosen by applicants and now recited in the claims, MPEP 2163.05, Section III.

Applicants believe the basis for this rejection has been overcome by amending the claims to use actual values directly from Table I.

As a courtesy, Applicants respectfully request that the Examiner quote the specific passage from MPEP 2163.05, Section III, that he relies on for a strict rule for “specific support,” as Applicants’ undersigned representative has read this section without finding any such rigid rule, but instead finds *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), which allows for the amendments found unacceptable by the Examiner.

Rejections under 35 USC §103

Each of the §103 rejections was on the general basis that Wood and Shaw disclose alloys whose elements have ranges that overlap Applicants’ claimed ranges. Applicants respectfully traverse each of these rejections in view of the claims as amended and the following comments.

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Under the first §103 rejection (claims 1-10), Wood was cited for disclosing a similar nickel-base alloy with alloying ranges that overlap those of claims 1-10 except for a maximum aluminum content of 1.5 weight percent, which the Examiner concluded was not patentably distinguishable from Applicants' claimed aluminum content of "about 1.75%."

As now amended, the tantalum content in Applicants' independent claims 1 and 10 is limited to 1.61% to 1.63% (Alloys 5-8 in Table I), compared to Wood's maximum tantalum content of 1.5%. In addition, dependent claims 3 and 24 recite an aluminum content of about 2.21%, dependent claim 21 recites an aluminum content of 1.75%, and dependent claim 25 recites an aluminum content of 2.26%, compared to Wood's maximum aluminum content of 1.5%.

Because Wood teaches that the Al+Ti, Al, and Ti contents are "critical aspects" of Woods alloy (column 2, line 66-column 3, line3), Applicants believe that nothing in Wood suggests that an alloy of the type taught by Wood would be acceptable with an aluminum content above 1.5%. Applicants also believe that nothing in Wood suggests that an alloy of the type taught by Wood would be acceptable with a tantalum content of above 1.5%.

For the above reasons, Applicants respectfully request withdrawal of the first §103 rejection of claims 1-10 based on Wood.

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Under the second §103 rejection (claims 1-20), Shaw was cited for disclosing a similar nickel-base alloy with alloying ranges that overlap those of claims 1-20. As now amended, the sum of aluminum and titanium in Applicants' independent claims is limited to 3.89% (independent claims 1 and 10) or 3.84% (independent claims 11 and 20), and is further limited by Applicants' dependent claims to 2.97% (claims 2 and 23), 3.54% (claims 7-9, 22, and 26), 3.05% (claims 12 and 29), and 3.62% (claims 17-19, 28, and 31).

In contrast, Shaw requires an Al+Ti content of 4% to 6.5%. Of the numerous alloys evaluated by Shaw, none had an Al+Ti content of below 4% (see Tables 1-6). Nothing in Shaw teaches or suggests that Shaw's alloy would be acceptable with an Al+Ti content of less than 4%. Instead, Shaw teaches that the Al+Ti content "should be from 4 to not more than 6.5%" (column 2, lines 11-13), and emphasizes "[t]he need to maintain the amounts of . . . titanium [and] aluminum . . . within the above defined ranges" (column 4, lines 31-35; emphasis added). Therefore, Applicants believe that Shaw teaches away from Applicants' claimed Al+Ti range, and Applicants respectfully request withdrawal of the second §103 rejection.

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Double Patenting Rejection

This rejection was on the basis that claims 1-10 of Beck disclose an alloy whose elements, with the exception of titanium, overlap those recited in claims 1-10. In their previous response filed July 30, 2003, Applicants acknowledged that the present application and Beck are commonly assigned, and requested the double patenting rejection be held in abeyance until allowable subject matter has been indicated by the Examiner. At that time, if appropriate a terminal disclaimer pursuant to 37 CFR §1.321(b) will be submitted which terminally disclaims that portion of the patent issuing from the present patent application which extends beyond the termination date of Beck.

Closing

Should the Examiner have any questions with respect to any matter now of record, Applicants' representative may be reached at (219) 462-4999.

Respectfully submitted,

By 
Gary M. Hartman
Reg. No. 33,898

June 7, 2006
Hartman & Hartman, P.C.
Valparaiso, Indiana 46383
TEL.: (219) 462-4999
FAX: (219) 464-1166